

REMARKS

Applicant has introduced new Claim 7 which has the exact same wording as the inadvertently canceled Claim 2. Claim 4 has been amended to depend from new Claim 7 rather than canceled Claim 2.

In the Office Action, the Examiner rejected Claims 1 and 3-6 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, applicant has adopted the Examiner's suggestion of using means plus function language to get around the confusion. Therefore, applicant respectfully requests removal of this ground of rejection.

The Examiner then rejected Claims 1, 3, and 5 under 35 U.S.C. 102(b) as being anticipated by Miller et al. (U.S. Patent No. 3,584,958). Applicant respectfully requests reconsideration and removal of this ground of rejection.

More particularly, applicant avers that the Examiner has misconstrued the disclosure of the Miller reference. Miller discloses an "identification system for identifying an individual." (Abstract) Miller accomplishes this by comparing a person's fingerprint against a previously recorded fingerprint from that same person. In Miller, this previously recorded fingerprint can be "contained on a master record means in the form of an identification card issued to the individual for subsequent use at the time the identification is to be made." (Col. 3, lines 51-56). In this embodiment, the person must physically have the card somewhere on his/her person, in order to utilize the card. This is exactly the problem that the present invention solves: "The system according to the present invention advantageously...avoids the use of any type of payment medium, thus **completely eliminating the encumbrance of these devices, the necessity of having to carry them around and the possibility of losing them.**" (page 3, lines 10-17) (emphasis added). In contrast, Miller's invention requires the user to carry a card, with the inherent problems of encumbrance and possibility of loss.

Another embodiment of Miller does disclose storing the previously recorded fingerprint data in the system itself. (Col. 10, lines 4-11). However, even in this embodiment, "the individual may be **given a number** which he will set on suitable

means on the identifying device” (Col. 10, lines 30-31) or “the individual may be **supplied with a card** which is keyed to the appropriate number of the central reference representing the desired master print.” (Col. 10, lines 34-36) (emphasis added).

Therefore, there exists in this embodiment the same inherent problems of carrying around the card, losing the card, or forgetting the number. Applicant’s invention requires the individual have only a finger. Miller requires a finger plus either a card or a memorized number. Thus, Miller did not disclose, teach, or claim how to identify an individual through a fingerprint using *only* the individual’s fingerprint. Therefore, applicant respectfully requests removal of this ground of rejection.

The Examiner then rejected Claims 4 and 6 under 35 U.S.C. 103(a) as being unpatentable over Miller et al. in view of Rivalto (U.S. Patent No. 5,482,139). Applicant respectfully requests reconsideration and removal of this ground of rejection.

More specifically, applicant avers that it would not have been obvious to one of ordinary skill in the art to combine the two references in order to create that which applicant regards as the invention. Miller is directed towards a system for identifying an individual (the title of the invention is “Identification System”). Rivalto is directed towards specialized vending facilities (the title of the invention is “Automated Drive-Up Vending Facility”). It would not have been obvious for one skilled in the art of fingerprint recognition to combine a feature from what is essentially an efficient marketing and sales technique with features from fingerprint recognition technology.

Additionally, even if the two references were combined, one having ordinary skill in the art would not create the invention as claimed in the amended claims because neither of the two references suggests, teaches, or discloses the use of only a fingerprint – both references require a card or memorized number of some sort. As discussed above, Miller requires that an individual either carry a card or memorize a number. Both techniques have inherent problems of losing the card or forgetting the number, among others, as detailed above. Rivalto, too, requires that an individual “insert an account/debit card into a card reader” on an ATM (Col. 4, lines 21-22). Additionally, “each ATM unit...includes the card reader device” (Col. 4, lines 33-34). Therefore, the invention of Rivalto has the same inherent problem as Miller, i.e., there is the danger of losing one’s card. Therefore, even if one of ordinary skill in the art were to combine the

two cited references, applicant's invention that utilizes only a finger – and not a card – would not have been created. Therefore, applicant respectfully requests removal of this ground of rejection.

In light of the foregoing applicant respectfully submits that the claims of the present application are in proper form for allowance.

An early and favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. Costigan', with a long horizontal flourish extending to the right.

James V. Costigan
Reg. No. 25,669

Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, NY 10036
212-302-8989